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10/032,796	12/26/2001	Mark Thompson	020375-003900US	7212

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EXAMINER
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JACOBS, LASHONDA T

ART UNIT	PAPER NUMBER
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2157

DATE MAILED: 11/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/032,796

Applicant(s)

THOMPSON ET AL.

Examiner

LaShonda T. Jacobs

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Amendment*

This is a Final Office Action in response to Applicants Amendment/Request for Reconsideration filed on August 29, 2006. Claims 1-16 are presented for further examination.

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 6, 11 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Giroux (US Pat. No. 6,289,347).

As per claim 1, Giroux discloses a method for auditing forms, the method comprising:

- issuing a request to provide a form identifier that is associated with a form ( col. 6, lines 10-31);
- receiving the identifier at a host computer (col. 3, lines 30-36 and col. 6, lines 10-31);
- and
- verifying with the host computer whether the identifier is a valid identifier for the form being used (col. 6, lines 10-31).

As per claim 6, Giroux discloses:

- wherein the host computer includes an associated database, and wherein the identifier is verified by comparing the identifier with a list of valid identifiers in the database (col. 6, lines 10-31).

As per claim 11, Giroux discloses a forms auditing system:

- host computer (col. 3, lines 30-36); and
- a database associated with the host computer, the database having a record of a set of forms and a valid identifier for each of the forms (col. 6, lines 10-31);
- wherein host computer is configured to receive an identifier in response to a request to audit a form, and to verify whether the identifier is a valid identifier for the audited form by comparing the identifier with the identifiers with the identifiers in the database, and to produce a record in the database of the comparison (col. 3, lines 30-36 and col. 6, lines 10-31).

As per claim 16, Giroux discloses a forms auditing system, comprising:

- a form identifier that is associated with a form (col. 6, lines 10-31);
- host computer (col. 3, lines 30-36); and
- a database associated with the host computer, the database having a record of a set of forms and a valid identifier for each of the forms (col. 6, lines 10-31);
- wherein host computer is configured to receive an identifier in response to a request to audit a form, and to verify whether the identifier is a valid identifier for the audited form by comparing the identifier with the identifiers with the identifiers in the database, and to produce a record in the database of the comparison (col. 3, lines 30-36 and col. 6, lines 10-31).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2-3, 5 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giroux in view of Bishop et al (hereinafter, "Bishop" U.S. Pub. No. 2006/0012473).

As per claim 2, Giroux discloses:

- wherein the request is issued from a terminal having a processor that is in communication with the host computer (col. 6, lines 10-31).

However, Giroux does not explicitly disclose:

- logging an error if the identifier is not valid.

Bishop discloses a system and method for securing Radio Frequency (RF) using a RF identification transaction device comprising:

- logging an error if the identifier is not valid (paragraphs 0053-0055 and 0066; Bishop discloses if the identifier entered by the user is invalid, an "invalid" or "transaction invalid" message is sent to the user.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement or incorporate Bishop's logging an error if the identifier is not valid in Giroux's method in order to lessen the loss associated with fraudulent usage.

As per claim 3, Giroux discloses:

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- wherein the request is sent from the host computer to the terminal (col. 3, lines 30-36 and col. 6, lines 10-31).

As per claim 5, Giroux discloses:

- wherein the identifier is received at the host computer from the terminal (col. 3, lines 30-36 and col. 6, lines 10-31).

As per claim 15, Giroux discloses the invention substantially as claims discussed above.

However, Giroux does not explicitly disclose:

- wherein the host is configured to generate an error report if the identifier of the form being audited is not valid.

Bishop discloses a system and method for securing Radio Frequency (RF) using a RF identification transaction device comprising:

- wherein the host is configured to generate an error report if the identifier of the form being audited is not valid (paragraphs 0053-0055 and 0066; Bishop discloses if the identifier entered by the user is invalid, an “invalid” or “transaction invalid” message is sent to the user.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement or incorporate Bishop’s logging an error if the identifier is not valid in Giroux’s method in order to lessen the loss associated with fraudulent usage.

5. Claims 4, 7-10, and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giroux in view of Klingman et al (hereinafter, “Klingman”, U.S. Pat. No. 5,799,285

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As per claim 4, Giroux discloses the invention substantially as claims discussed above.

However, Giroux does not explicitly disclose:

- where the request is issued from a customer service operator over the phone.

Klingman discloses a secure system for electronic selling comprising:

- where the request is issued from a customer service operator over the phone (col. 9, lines 10-25).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Giroux by implementing or incorporating a customer service operator to receive and process requests over the telephone in a timely and efficient manner.

As per claim 7, Giroux discloses the invention substantially as claims discussed above.

However, Giroux does not explicitly disclose:

- determining whether an appropriate form has already been ordered.

Klingman discloses a secure system for electronic selling comprising:

- determining whether an appropriate form has already been ordered (col. 10, lines 47-56).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Giroux by implementing or incorporating a auditing system to automatically keep accurate records of orders that have been places in a timely and efficient manner.

As per claim 8, Giroux discloses the invention substantially as claims discussed above.

However, Giroux does not explicitly disclose:

- wherein if an appropriate form has not been ordered, placing an order for an appropriate form.

Klingman discloses a secure system for electronic selling comprising:

- wherein if an appropriate form has not been ordered, placing an order for an appropriate form (col. 10, lines 55-65).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Giroux by implementing or incorporating a auditing system to automatically keep accurate records of orders that have been places in a timely and efficient manner.

As per claim 9, Giroux discloses the invention substantially as claims discussed above.

However, Giroux does not explicitly disclose discloses:

- evaluating whether the ordered form is received by a user.

Klingman discloses a secure system for electronic selling comprising:

- evaluating whether the ordered form is received by a user (col. 9, lines 47-60).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Giroux by implementing or incorporating a auditing system to automatically keep accurate records of orders that have been places in a timely and efficient manner.

As per claim 10, Giroux discloses:

- transmitting an identifier for a replacement form to the host computer (col. 6, lines 10-31).



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As per claim **12**, Giroux discloses the invention substantially as claims discussed above.

However, Giroux does not explicitly disclose:

- a terminal having a processor, wherein the terminal is configured to receive the identifier of the form being audited and to electronically send the identifier to the host computer.

Klingman discloses a secure system for electronic selling comprising:

- a terminal having a processor, wherein the terminal is configured to receive the identifier of the form being audited and to electronically send the identifier to the host computer (col. 15, lines 46-58).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Giroux by implementing or incorporating a auditing system to automatically keep accurate records of orders that have been places in a timely and efficient manner.

As per claim **13**, Giroux discloses the invention substantially as claims discussed above.

However, Giroux does not explicitly disclose:

- wherein the terminal is configured to produce an audit screen having a region for inputting the identifier.

Klingman discloses a secure system for electronic selling comprising:

- wherein the terminal is configured to produce an audit screen having a region for inputting the identifier (col. 16, lines 3-15).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Giroux by implementing or incorporating a auditing system to

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automatically keep accurate records of orders that have been places in a timely and efficient manner.

As per claim 14, Giroux discloses the invention substantially as claims discussed above.

However, Giroux does not explicitly disclose:

- wherein the terminal is configured to produce an audit screen based on information sent to the terminal from the host computer.

Klingman discloses a secure system for electronic selling comprising:

- wherein the terminal is configured to produce an audit screen based on information sent to the terminal from the host computer (col. 16, lines 25-50).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Giroux by implementing or incorporating a auditing system to automatically keep accurate records of orders that have been places in a timely and efficient manner.

### ***Response to Arguments***

6. Applicant's arguments filed August 29, 2006 have been fully considered but they are not persuasive.

The Office Notes the following arguments:

a. Significant limitations from independent claims 1, 11 and 16 are neither taught nor suggested in the references. The references cannot be relied upon to teach or suggest "receiving an identifier in response to a request audit form" or "verifying whether the form identifier is a valid form identifier for the form to audited".

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b. Giroux fails to teach or suggest the determination of whether a form or its identifier is valid.

c. Applicants argue that the Bishop reference is not prior art to set forth a proper prima facie case. Bishop is a patent Publication with a filing date of December 9, 2004 with CIP to a number of earlier patents; the only proper citation is to a parent with an earlier priority date and which a cited limitation is found.

In response to:

(a)-(b), Applicants argue that the references cited cannot be relied upon to teach or suggest “receiving an identifier in response to a request audit form” or “verifying whether the form identifier is a valid form identifier for the form to audited” or “the determination of whether a form or its identifier is valid”. However, the Examiner disagrees. Giroux teaches data processing system utilizing web forms in which forms are stored within a database with a form version. A user requests a particular form from the database. The form is retrieved from the database by reading the form identifier and version number from the header. The version number is utilized to identify when a form has been updated and is download when the requested version does not match the version saved (col. 6, lines 15-53). Therefore, Giroux discloses “receiving an identifier in response to a request audit form”, “verifying whether the form identifier is a valid form identifier for the form to audited” and “the determination of whether a form or its identifier is valid”.

(c) Applicants argue that the Bishop reference is not prior art. However, the Bishop reference was applied in the previous Office Action dated February 14, 2006 by Examiner Barbara

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Burgess in which a response was filed on May 8, 2006 did not state that the Bishop reference was not prior art. Also the Bishop reference has a priority date of July 10, 2001.

### *Conclusion*

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LaShonda T. Jacobs whose telephone number is 571-272-4004. The examiner can normally be reached on 8:30 A.M.-5:00 P.M..


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on 571-272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

LaShonda T Jacobs  
Examiner  
Art Unit 2157

ltj  
November 10, 2006

  
**ARIO ETIENNE**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 2157**